

AKIN GUMP STRAUSS HAUER & FELD LLP
ATTORNEYS AT LAW
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, PA 19103
TELEPHONE: (215) 965-1200 - FACSIMILE: (215) 965-1210
E-MAIL: kbullock@akingump.com

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FACSIMILE COVER SHEET

Examiner: Abdel A. Mohamed

FAX No.: 703-872-9307

Group Art Unit: 1653

Date: October 27, 2003

From: Kristyne A. Bullock

FAX Operator: Catherine Bonner

Re: U.S. Patent Appln. No. 09/309,689 of Norman Orentreich for Materials for Soft Tissue
Augmentation and Methods of Making and Using Same

Title of Paper sent via Facsimile: PETITION UNDER 37 C.F.R. § 1.181(a) TO WITHDRAW
THE FINALITY OF THE PENDING OFFICE ACTION

Time: 4:40 p.m.

Akin Gump File No: 4555-45US

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VIA FACSIMILE**OFFICIAL****PATENT
Attn: Group Director****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Patent Application of: :
Norman Orentreich, *et al.* :
Conf. No.: 7858 : Group Art Unit: 1653
Appln. No.: 09/309,689 : Examiner: A. Mohamed
Filing Date: May 11, 1999 : Attorney Docket No.: 4555-45US
Title: MATERIALS FOR SOFT TISSUE AUGMENTATION AND METHODS OF
MAKING AND USING SAME

**PETITION UNDER 37 C.F.R. § 1.181(a) TO WITHDRAW THE FINALITY OF THE
PENDING OFFICE ACTION**

The applicants hereby petition for the withdrawal of the finality of the Office Action mailed September 17, 2003 (Paper No. 22) (hereinafter the "Office Action") under 37 C.F.R. § 1.181(a) and M.P.E.P. § 706.07. Supplementation of the Office Action, as described below, and reissuance of the Office Action as a non-final action, including a re-starting of the time for response, is hereby requested.

The Office Action is improperly made final, as it contains unclear grounds of rejections which may not have been previously set forth by the Examiner in prior Office Actions, yet which do not address the claims as amended, and it is premature as the applicants, having filed an RCE to secure admittance of amended claims and a Declaration Under § 1.132, have not been permitted an opportunity to address the Examiner's objections without being under final.

Pursuant to M.P.E.P. § 706.07:

Before a final rejection is in order, a clear issue should be developed between the Examiner and the applicants. To bring the prosecution to as speedy a conclusion as possible and at the same time to deal justly with both the applicant and the public. ... The applicant who is seeking to define his or her invention in claims that would give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to

Application No. 09/309,689

Petition re Office Action of September 17, 2003

that end, and should not be prematurely cut off in the prosecution of his or her applicant. ... The Examiner should never lose sight of the fact that in every case the application is entitled to a full and fair hearing, and that a clear issue between the applicant and the Examiner should be developed, if possible, before appeal.

M.P.E.P. § 706.07. The finality of the present Office Action is not in accordance with these guidelines. Paper No. 22 was made final after applicants filed an Amendment After Final, with a Declaration *inter alia*, rebutting the Examiner's unsupported inherency determination accompanied by an RCE, so as to ensure entrance of the amended, fully patentable claims, and secure a reasonably speedy allowance of the application in accordance with PTO procedures. In the present case, an Examiner has improperly used a procedural requirement against the applicants to force a final rejection in a First Office Action without ever affording the applicants an opportunity to address the Examiner's concerns as to the newly amended claims without being under final. The applicants are being penalized for undertaking to streamline the After Final process in order to conserve resources of both the PTO and applicants. Moreover, since finality is a trigger for a right of appeal, such a premature final rejection places the application in the position for appeal without a fully developed record on the claims to which an appeal would be directed. See M.P.E.P. § 706.07.

In addition, the Examiner himself has clouded the record by making it unclear the basis of the § 103(a) rejection(s). In Paper No. 22, the Examiner has stated that all pending claims are rejected under 35 U.S.C. § 103(a): "As being unpatentable over Coleman, III, *et al.* [] or Pollack [] in view of Grabarek *et al.* [] or Wong [] or Wang []." Paper No. 22 at 3. It is unclear from this statement, and the subsequent analysis provided allegedly in support of this statement, whether the Examiner is maintaining the prior two 103(a) rejections set forth in his prior Office Action, or is asserting six new prior art combinations on the basis of which the claims are allegedly obvious. Should applicants wish to appeal, as is their right, neither they nor the Board could discern from the written record what the basis of the rejection is. The Office Action is clearly improper under the relevant rules, and should be withdrawn.

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For the reasons described above, the applicants respectfully submit that the pending Office Action is improper and premature. Withdrawal of the finality and issuance of a replacement, non-final Office Action in which the grounds of the asserted § 103 rejection or rejections are clearly outlined is respectfully requested.

It is believed that no fee is due for a petition under 37 C.F.R. § 1.181. However, in the event that a fee is required, the Commissioner is hereby authorized to charge deposit account number 50-1017 (Billing No.: 204555.0045) any petition fee that is required. A duplicate copy of this Petition is enclosed for accounting purposes.

Respectfully submitted,

NORMAN ORENTREICH, *ET AL.*

27 October 2003
(Date)

By:

Kristyne A. Bullock

KRISTYNE A. BULLOCK

Registration No. 42,371

AKIN GUMP STRAUSS HAUER & FELD LLP

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103-7013

Telephone: 215-965-1200

Direct Dial: 215-965-1348

Facsimile: 215-965-1210

E-Mail: kbullock@akingump.com

KAB:cmb
7075036

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